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No. 15-927

IN THE

Supreme Court of the United States

SCA HYGIENE PRODUCTS AKTIEBOLAG and SCA PERSONAL CARE, INC.,

Petitioners,

v.

FIRST QUALITY BABY PRODUCTS, LLC, FIRST QUALITY HYGIENIC, INC., FIRST QUALITY PRODUCTS, INC. and FIRST QUALITY RETAIL SERVICES, LLC,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF INTELLECTUAL PROPERTY OWNERS ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Intellectual Property Owners Association (IPO) is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights.[1] IPO's membership includes roughly 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm, or attorney member. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO regularly represents the interests of its members before Congress and the United States Patent and Trademark Office and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of IPO's Board of Directors, which approved the filing of this brief, are listed in the Appendix.[2]

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[1] No party's counsel authored this brief in whole or part; no party or party's counsel contributed money intended to fund preparing or submitting the brief; and no person other than *amicus*, its members, or counsel contributed money intended to fund preparing or submitting the brief. Counsel for all parties have consented to the filing of this brief.

[2] IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

SUMMARY OF THE ARGUMENT

I. Almost 25 years ago, the *en banc* Federal Circuit analyzed the text and history of 35 U.S.C. § 286, as enacted by the Patent Act of 1952, and held that the equitable doctrine of laches could bar a claim for damages based on patent infringement occurring within the six-year period established by section 286. *See A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1031 (Fed. Cir. 1992) (*en banc*). In this case, the Federal Circuit reaffirmed that holding, again *en banc*. This Court, too, should affirm.

First, this Court's holding, in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014), that laches could not bar a claim for damages based on copyright infringement, does not control this case, because the patent and copyright statutes are meaningfully different. *Petrella* turned on the existence of a comprehensive statute of limitations for copyright infringement. *See* 17 U.S.C. § 507(b). This case, however, involves a very different statutory provision contained in the Patent Act, 35 U.S.C. § 286, which does not impose a statute of limitations on patent cases. Section 507(b) of the Copyright Act was a congressional pronouncement that defined the timeliness of all claims for copyright infringement, leaving no room for equity to fill gaps via laches. The same cannot be said, however, of the six-year damages limit in section 286 of the Patent Act, which, unaccompanied by the gap-filling work of laches, would leave patent law entirely bereft of a limitation on stale claims.

Second, the legislative history of the 1952 Patent Act establishes Congress's intention that laches remain a bar to claims of patent infringement.

Federal courts had long applied laches in patent-infringement cases when Congress recodified the six-year provision in section 286 without substantial change. Moreover, a commentary on the 1952 Patent Act written by one of the Act's drafters, P.J. Federico, explicitly contemplates that laches would continue to be a defense to patent-infringement actions.

Third, basic considerations of fairness, which are magnified in the patent context as compared to copyright cases, require that laches remain a viable defense to bar stale patent-infringement claims. Without laches, defendants could in good faith build entire businesses during a patentee's lengthy delay, only to lose everything in an unreasonably belated infringement suit.

II. Laches applies not only to bar a claim for damages incurred prior to suit, but it should also be available to bar a claim for injunctive relief, or an entire suit. This conclusion is compelled by prior decisions of this Court, such as *Lane & Bodley Co. v. Locke*, 150 U.S. 193 (1893), and *Petrella*, 134 S. Ct. 1962. Indeed, it would be incongruous with these cases if an equitable defense such as laches could not bar, in appropriate cases, equitable relief. Moreover, in light of those equitable roots, laches is a flexible doctrine committed to the discretion of district courts. Accordingly, in appropriate circumstances, judges may invoke the doctrine to bar damages, injunctions, or entire suits.

ARGUMENT

I. Laches should remain available to bar a claim for damages based on patent infringement occurring within the six-year damages period of 35 U.S.C. § 286.

The doctrine of laches is a "nonstatutory time bar[] to suit[] or to particular remedies," developed in English courts of equity. 6A Donald S. Chisum, *Chisum on Patents* § 19.05 (Matthew Bender 2014). "In early English practice, most actions 'at law' for monetary damages fell under express statutes of limitations stating a set number of years for filing suit after a cause of action arose." *Id.* By contrast, equitable suits "for remedies such as an injunction, specific performance, or rescission did not fall under such statutes." *Id.* Nevertheless, "on policy grounds, equity declined to afford relief on 'stale demands.'" *Id.*

U.S. courts have long incorporated this doctrine. *See generally* 27A Am. Jur. 2d *Equity* (2d ed. 2015); 2 John Norton Pomeroy, *A Treatise on Equity as Administered in the United States of America* §§ 418-419 (5th ed. 1941); 3 William C. Robinson, *The Law of Patents for Useful Inventions* § 1114 (1890). As this Court noted in 1893, courts of equity would "not assist one who [had] slept upon his rights, and show[ed] no excuse for his laches in asserting them." *Lane & Bodley Co.*, 150 U.S. at 201. As in England, the principle was "based upon grounds of public policy, which require for the peace of society the discouragement of stale demands." *Mackall v. Casilear*, 137 U.S. 556, 566 (1890).

Today, consistent with its historical roots, the laches defense requires "proof of (1) lack of diligence by the party against whom the defense is asserted, and

(2) prejudice to the party asserting the defense." *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 122 (2002) (internal quotation marks omitted). When successful, laches "bars a plaintiff from maintaining a suit." *Id.* at 121.

Over one hundred years ago, laches branched out from equity and into the law. The doctrine was "adopted by common law courts and, following the merger of law and equity, became part of the general body of rules governing relief in the federal court system." *Envtl. Def. Fund, Inc. v. Alexander*, 614 F.2d 474, 478 (5th Cir. 1980). More specifically, the Law and Equity Act of 1915, 38 Stat. 956, provided that equitable defenses could be raised in courts of law, without need for a separate bill of equity. *See Aukerman*, 960 F.2d at 1031; *see also* Walter Wheeler Cook, *Equitable Defenses*, 32 Yale L.J. 645, 646 (1923). Two decades later, the Federal Rules of Civil Procedure joined equitable and legal claims into a single civil action. *See* Fed. R. Civ. P 2 ("There is one form of action—the civil action."); *see also Aukerman*, 960 F.2d at 1031. Today, those same Rules explicitly state that in response to a civil action, laches may be interposed as a defense.[3] *See* Fed. R. Civ. P 8(c)(1) ("In responding to a pleading, a party must affirmatively state any avoidance or affirmative defense, including ... laches....."). Given the merger of

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[3] Laches is not the only equitable defense that has migrated from equity to general application. For example, Rule 8 recognizes estoppel as a defense to legal claims, as does the Supreme Court. Fed. R. Civ. P 8(c)(1) (listing "estoppel" as an additional "avoidance or affirmative defense" to a civil action); *Petrella*, 134 S. Ct. at 1977 ("[E]stoppel may bar the copyright owner's claims completely.")

law and equity, courts "must give the relief to which the parties are entitled on the facts, applying the rules of both law and equity as a single body of principles and precedents." 4 Wright & Miller, Federal Practice & Procedure § 1041 (3d ed. 2014); *see also id.* § 1043 ("[T]he merger of law and equity and the abolition of the forms of action furnish a single uniform procedure by which a litigant may present his claim in an orderly manner to a court empowered to award whatever relief is appropriate and just.").

In the patent-infringement context, this Court's pre-merger cases recognized that laches could bar claims for equitable relief. *See Lane & Bodley Co.*, 150 U.S. at 201; *Leggett v. Standard Oil Co.*, 149 U.S. 287, 294 (1893); *Wollensak v. Reiher*, 115 U.S. 96, 99 (1885); *Mahn v. Harwood*, 112 U.S. 354, 363 (1884). As equity began to merge with law, lower courts recognized that laches could also bar legal claims. *See, e.g., Banker v. Ford Motor Co.*, 69 F.2d 665, 666 (3d Cir. 1934). The Federal Circuit's 1992 decision in *Aukerman* was of a piece, holding that laches could bar claims for damages incurred prior to suit in patent-infringement cases.

As the Federal Circuit here properly recognized, that holding of *Auckerman* remains good law. In *Petrella*, this Court held that laches could not bar claims for *copyright* damages. Petitioners here suggest that any different result for patent cases reflects an impermissible "patent law exceptionalism." Pet. 20-21. However, the different results follow directly from fundamentally different statutory schemes: the statutory structure of the Copyright Act contains an express statute of limitations, whereas the Patent Act does not, thereby demonstrating that

laches remains necessary to prevent litigation of stale patent-infringement claims. Moreover, the legislative history of the Patent Act underscores the conclusion that laches is available as a bar to legal relief. Finally, practical considerations of fairness—the need to afford certainty to investors and protect their investments—weigh in favor of retaining laches as a bar to damage claims in patent-infringement suits.

A. *Petrella* jettisoned laches for copyright cases in light of the Copyright Act's statute of limitations; the Patent Act lacks such a statute of limitations.

In *Petrella*, this Court held that laches did not apply to claims for damages based on copyright infringement in light of the Copyright Act's three-year statute of limitations. 134 S. Ct. 1962. This case, by contrast, involves a claim for patent infringement, and the Patent Act lacks such a statute of limitations. Given these fundamental distinctions, *Petrella* does not require that the two very different statutes be read *in pari materia*. Rather, the differences between the two statutory regimes' approaches compel the conclusion that laches must be available as a defense in patent-infringement suits. Indeed, the language and logic of *Petrella* confirms the need for laches in patent cases.

In *Petrella*, this Court held that, "in face of a statute of limitations enacted by Congress, laches cannot be invoked to bar legal relief." 134 S. Ct. at 1974. The Court further explained that the Copyright Act "bars relief of any kind for conduct occurring prior to [a] three-year limitations period," and concluded that laches could not be invoked "to jettison Congress' judgment on the timeliness of suit." *Id.* at 1967. That holding was compelled by the statute of limitations

contained in the Copyright Act, which provides that "[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued." 17 U.S.C. § 507(b). In short, the Copyright Act categorically bars *all* claims that are not timely commenced.

The Patent Act takes a very different approach. Section 286 reads: "Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action." This provision merely restricts damages to the six-year period prior to the suit; it does not, as with 17 U.S.C. § 507(b), "ba[r] relief of any kind for conduct occurring prior to [the] limitations period." *Petrella*, 134 S. Ct. at 1967.

This Court's recent decision in *CTS Corp. v. Waldburger* is particularly instructive. There, the Court explained that, "[i]n the ordinary course, a statute of limitations creates 'a time limit for suing in a civil case, based on the date when the claim accrued.'" 134 S. Ct. 2175, 2182 (2014); *see also Lozano v. Montoya Alvarez*, 134 S. Ct. 1224, 1234 (2014) (citing *Heimeshoff v. Hartford Life & Accident Ins. Co.*, 134 S. Ct. 604, 610 (2013)); *Beach v. Ocwen Fed. Bank*, 523 U.S. 410, 416 (1998). Importantly, Section 286 does not bar actions; it merely restricts the duration for which damages can be recovered.

As a result, the holding and reasoning of *Petrella* do not affect the availability of laches in patent cases. In the Copyright Act, Congress, by enacting a specific bar on untimely claims, in effect occupied the field and left no room for laches to perform an equitable, gap-filling

role. By contrast, in the Patent Act, Congress left much room for laches to act.

This Court's decision in *Young v. United States*, 535 U.S. 43 (2002), does not require a different conclusion. *Young* involved provisions of the Bankruptcy Code that granted priority and nondischargeability rights to the IRS, but only regarding taxes owed on returns due in the three years prior to the filing of the bankruptcy petition. The Court held that the "three-year lookback period" in the Bankruptcy Code was a "limitations period subject to traditional principles of equitable tolling." *Id.* at 47. In so holding, the Court commented that "unlike most statutes of limitations, the lookback period bars only *some*, and not *all*, legal remedies for enforcing the claim (viz., priority and nondischargeability in bankruptcy)," but according to the Court, the lookback period was "a statute of limitations nonetheless." *Id.* at 47-48. *Young's* language cannot properly be stretched to suggest that section 286 is a statute of limitations that leaves no room for laches to operate. The Court's conclusion that sections 507(a)(8)(A)(i) and 523(a)(1)(A) of the Bankruptcy Code constitute a statute of limitations for purposes of equitable tolling does not require the conclusion that section 286 of the Patent Act is a statute of limitations for purposes of preempting laches, particularly in light of the weight of authority defining statutes of limitations as bars to suit.

Moreover, *Petrella* did not turn on superficial labels. Rather, it rested upon a careful examination of section 507(b), which expressly occupied the timeliness field and left no room for laches. Indeed, the Court explained that prior to 1957, the Copyright Act had lacked a statute of limitations, but in that year,

Congress "*filled the hole*" and prescribed a three-year limitations period "for all civil claims." 134 S. Ct. at 1968 (emphasis added). The Court thus deemed section 507(b) to be a "time-to-sue prescription," *id.* at 1978, reflecting "Congress' judgment on the timeliness of suit" and "*bar[ring] relief of any kind*," *id.* at 1967 (emphasis added). The Court thus concluded that the current copyright regime "leaves 'little place' for a doctrine that would further limit the timeliness of a copyright owner's suit." *Id.* at 1977. It is therefore clear that section 507(b) is an all-encompassing statute of limitations, and that fact fueled the Court's reasoning in *Petrella* that laches had no place as a copyright-infringement defense.

By contrast, section 286 of the Patent Act simply restricts damages to a six-year duration. Thus, under the Patent Act, there is still a hole to fill—and filling that statute-of-limitations void to barring stale claims is a vital function of laches. Whereas the Copyright Act's statute of limitations guarantees that following a final act of infringement, a potential accused copyright infringer will be entitled to repose after a period of three years, the Patent Act does not offer that same protection. Laches must step in to do that job.

The fact that the role for laches is different as between patent and copyright cases stems not from so-called "patent law exceptionalism," but from the fundamental textual and structural differences between the patent statutes and the copyright statutes. That makes this case fundamentally different from those for which the Federal Circuit has been reversed for creating special patent exceptions to rules of general application. *See, e.g., eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (no

presumption of irreparable harm for injunctions in patent cases); *MedImmune v. Genentech*, 549 U.S. 118 (2007) (no special patent rules for declaratory-judgment actions in patent cases). Moreover, while copyright and patent law might share a "historic kinship" as a general matter, the two arise from different statutory regimes located in titles 17 and 35, respectively, of the United States Code. And the basic textual and structural differences between the two regimes should be honored. *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 345-46 (1908) ("There are such wide differences between the right of multiplying and vending copies of a production protected by the copyright statute and the rights secured to an inventor under the patent statutes, that the cases which relate to the one subject are not altogether controlling as to the other."). While Congress "filled the hole" where laches might have operated in copyright cases, it has for over 100 years maintained a gap in the Patent Act where laches has properly served its important role.

B. Legislative history and historical practice demonstrate Congress's intent that laches remain available to bar a claim for damages.

In *Petrella*, this Court recognized that, in the Patent Act context, "[b]ased in part on [35 U.S.C. § 282] and commentary thereon, legislative history, and historical practice, the Federal Circuit has held that laches can bar damages incurred prior to the commencement of [a] suit." 134 S. Ct. at 1974 n.15. Indeed, historical practice, legislative history, and commentary on section 282 demonstrate that

notwithstanding section 286, laches has a vital role to play as a defense to patent infringement.

Canvassing relevant precedent against the legislative backdrop of the 1952 Patent Act, the Federal Circuit determined that "the case law strongly supports the availability of laches to bar legal relief. Section 282 codified whatever laches doctrine existed when Congress enacted the Patent Act in 1952. Although the development occurred over time, by 1952 nearly every circuit had approved of the proposition that laches could bar legal relief for patent infringement, and no court had held to the contrary." *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 807 F.3d 1311, 1328 (Fed. Cir. 2015) (*en banc*). The court of appeals' conclusions were well grounded.

As *Aukerman* explained, "[f]or the brief time of 1870-1874, the patent statute contained an actual statute of limitations which required 'all actions for the infringement of patents shall be brought during the term for which letters patent shall be granted or extended, or within six years after the expiration thereof.'" 960 F.2d at 1030 n.8 (quoting 16 Stat. 206, § 55 (July 8, 1870)). That provision, however, was rather promptly abrogated. In 1897, a six-year recovery period was added, *see* 29 Stat. 692, 694, § 6 (1897),[4] and U.S. patent law has contained substantially the same provision ever since, *see Aukerman*, 960 F.2d at 1030 ("[T]he statutory

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[4] "But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action."

language of section 286 was virtually identical to a predecessor provision under which laches was also recognized.").

With no statute of limitations contained in the Patent Act since 1874, federal courts quite sensibly turned to the equitable doctrine of laches to bar unreasonably delayed claims in appropriate cases. Thus, by the time that the patent laws were recodified in the 1952 Patent Act, federal courts in nearly every circuit had recognized that laches was a defense to a charge of patent infringement, notwithstanding the presence of the six-year recovery bar in the statute. *See Meyrowitz Mfg. Co. v. Eccleston*, 98 F 437, 439-40 (C.C.D. Mass. 1899); *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 827 (2d Cir. 1928); *Banker v. Ford Motor Co.*, 69 F.2d 665, 666 (3d Cir. 1934); *Hartford-Empire Co. v. Swindell Bros., Inc.*, 96 F.2d 227, 233 (4th Cir. 1938); *Ford v. Huff*, 296 F. 652, 657-58 (5th Cir. 1924); *France Mfg. Co. v. Jefferson Elec. Co.*, 106 F.2d 605, 609 (6th Cir. 1939); *Brennan v. Hawley Prods. Co.*, 182 F.2d 945, 948 (7th Cir. 1950); *Montgomery Ward & Co. v. Clair*, 123 F.2d 878, 883 (8th Cir. 1941); *Gillons v. Shell Co.*, 86 F.2d 600, 606 (9th Cir. 1936); *cf. Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, 192 F.2d 620, 625 (10th Cir. 1951) (assuming the availability of laches but noting that "the plea of laches and estoppel finds no substantial basis in the record").[5] *See generally* 4 *Walker, on Patents* § 880B (Deller's ed. 1937).

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[5] In 1954, just two years after passage of the 1952 Act, the Tenth Circuit wrote, "On the question of laches, there are well-settled applicable rules of law. The rule is applicable in patent cases." *Potash Co. of Am. v. Int'l Minerals & Chem.*, 213 F.2d 153, 154 (10th Cir. 1954).

In 1952, when Congress recodified the patent laws and retained the six-year recovery period (but did not add a statute of limitations), it did so against this backdrop, in which the federal courts had uniformly embraced the availability of laches in patent cases. As this Court recently reiterated, "'[t]he stated purpose' of the 1952 revision 'was merely reorganization in language to clarify the statement of the statutes.'" *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1930 (2016). The uniform pre-1952 understanding of the U.S. Patent laws was that they allowed laches to bar claims in appropriate cases; the 1952 Act's reorganization for clarity should be read as continuing this understanding of the laws.

Accordingly, Congress's decision to continue the six-year recovery bar without change, and without the addition of a statute of limitations, reflects its acceptance of the role of laches as a defense to patent infringement. "Congress is understood to legislate against a background of common-law adjudicatory principles;" thus, "where a common-law principle is well established, ... the courts may take it as given that Congress has legislated with an expectation that the principle will apply except when a statutory purpose to the contrary is evident." *Astoria Fed. Sav. & Loan Ass'n v. Solimino*, 501 U.S. 104, 108 (1991) (internal quotation marks omitted); *see also McQuiggin v. Perkins*, 133 S. Ct. 1924, 1934 n.3 (2013) ("Congress legislates against the backdrop of existing law.").

This Court has frequently considered the effect of the 1952 Patent Act upon preexisting law, and has concluded, in analogous circumstances, that the 1952 Act evidenced no intent to alter a longstanding

common-law regime. *See, e.g., Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 102 (2011) (retaining clear-and-convincing-evidence standard for invalidity challenges in part because of the 1952 Act's silence on the subject, which required the court to "presume" that Congress intended to retain that standard of proof, as reflected in pre-1952 Act case law); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 26-27 (1997) (concluding that the doctrine of equivalents survived the 1952 Act, noting that, "[i]n the context of infringement, we have already held that pre-1952 precedent survived the passage of the 1952 Act," "see[ing] no reason to reach a different result here," and citing *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 342 (1961) for the proposition that a "new Patent Code, which defines 'infringement,' left intact the entire body of case law on direct infringement"). As the Federal Circuit properly concluded, the same analysis applies here and leads to the conclusion that the passage of the 1952 Patent Act—and that Act's retention of the six-year recovery period—did not disturb the uniform case law embracing laches as a supplemental equitable bar to stale claims.

Finally, as this Court noted in *Petrella*, section 282 and commentary thereon are relevant to maintaining the laches defense. Section 282(b) provides: "The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded: (1) Noninfringement, absence of liability for infringement or unenforceability." "P.J. Federico, a principal draftsman of the 1952 recodification," *Diamond v. Chakrabarty*, 447 U.S. 303, 309 n.6 (1980), wrote a contemporaneous commentary on those patent laws. The Federal Circuit has deemed "Federico's

commentary" to be "an invaluable insight into the intentions of the drafters of the Act," *Symbol Techs., Inc. v. Lemelson Med.*, 277 F.3d 1361, 1366 (Fed. Cir. 2002), and this Court, too, has looked to Federico in seeking to understand what the 1952 Act did, and did not, accomplish. *Warner-Jenkinson*, 520 U.S. at 28; *Aro*, 365 U.S. at 342 n.8. As relevant here, Federico's commentary confirms that the 1952 Patent Act retained the defense of laches. After quoting the language of section 282(b)(1), Mr. Federico writes that "this would include ... equitable defenses such as laches, estoppel and unclean hands." P.J. Federico, *Commentary on the New Patent Act*, reprinted in 75 J. Pat. & Trademark Off. Soc'y 161, 215 (1993). Given *Petrella's* directive, Federico's commentary is further compelling evidence that Congress did not intend to eradicate laches when it recodified the patent laws in 1952.

C. Retaining laches to bar damages claims serves important interests such as fairness and certainty, thereby protecting and incentivizing investment and innovation.

Laches promotes fairness by "assur[ing] that old grievances will some day be laid to rest, that litigation will be decided on the basis of evidence that remains reasonably accessible and that those against whom claims are presented will not be unduly prejudiced by delay in asserting them." *Aukerman*, 960 F.2d at 1029. To benefit from laches, a defendant must generally demonstrate unreasonable delay by the plaintiff and prejudice to the defendant. *See id.* at 1032. *Aukerman* identified two types of such prejudice—economic and evidentiary "Economic prejudice may arise where a defendant and possibly

others will suffer the loss of monetary investments or incur damages which likely would have been prevented by earlier suit." *Id.* at 1033. "Evidentiary ... prejudice," meanwhile, "may arise by reason of a defendant's inability to present a full and fair defense on the merits due to the loss of records, the death of a witness, or the unreliability of memories of long past events, thereby undermining the court's ability to judge the facts." *Id.* Those prejudices are not eliminated by the six-year recovery period.

The doctrine is especially critical in patent cases, where delay can lead to devastating economic prejudice. Based on a reasonable assumption that a plaintiff will not file suit, a defendant might invest heavily in researching and developing a product, expend significant resources to bring the product to market, extensively promote its use, and perhaps even build an entire business. (Copyrights, by contrast, typically do not engender the same kinds or scope of investments.) In such circumstances, if a plaintiff files suit an unreasonable number of years later, the defendant could face ruin. Whereas a prompt and justified suit could have led to fair and equitable damages, an unreasonably delayed suit could destroy what the defendant built in good faith. In the patent context, examples abound of defendants who have invested heavily in research, development, manufacturing, and marketing, and those heavy investments might not return dividends until many

years later.[6] As *Aukerman* correctly observed, plaintiffs should not be allowed to "intentionally lie silently in wait watching damages escalate, particularly where an infringer, if he had had notice, could have switched to a noninfringing product." 960 F.2d at 1033 (citation omitted). This is of particular concern in the case of non-practicing plaintiffs, who aggregate patent portfolios and then wait, opportunistically, to file an action until after a defendant has expended significant resources in developing a product. Laches thus operates to mitigate such "behavior [which] can impose a 'harmful tax on innovation.'" *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1930 (2015). Laches is necessary to prevent such unfair delay by plaintiffs, and protect such good-faith investments of defendants.

Delay can also lead to harmful evidentiary prejudice in patent cases. Documents or witnesses might be lost, and memories often fade. The Federal Circuit recently encountered an inventorship case in which "three witnesses with knowledge of [plaintiff's] inventorship claim ... [had] all died during the period of her delay"

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[6] For example, in this case "First Quality made a number of capital expenditures to expand its relevant product lines and to increase its production capacity. The record evidence suggests that First Quality would have restructured its activities to minimize infringement liability if SCA had brought suit earlier." *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods. LLC*, 767 F.3d 1339, 1347 (Fed. Cir. 2014); *see also, e.g., Tech. for Energy Corp. v. Computational Sys., Inc.*, Nos. 92-1542, -1551, 1993 U.S. App. LEXIS 24556, at *21 (Fed. Cir. Sept. 21, 1993) ("The district court relied on several pages of undisputed evidence showing that [defendant] expended considerable capital to expand its business in terms of, among other things, employees, sales, and investment in research and development during [plaintiff's] period of delay.").

and there was "cumulative and inherent prejudice from the dimming memories of all participants, including [plaintiff] herself." *Serdarevic v. Advanced Med. Optics, Inc.*, 532 F.3d 1352, 1360 (Fed. Cir. 2008). Such obstacles to a full and fair defense are not uncommon. *See, e.g., Odetics, Inc. v. Storage Tech. Corp.*, 919 F Supp. 911, 922 (E.D. Va. 1996), *vacated on other grounds*, 1997 U.S. App. LEXIS 15254 (Fed. Cir. June 25, 1997) (finding that "600 to 800 documents related to [defendant's] validity defense [had] been lost or destroyed," "key figures in the prosecution of the ... patent no longer recall[ed] facts that might well have aided [defendant] in defending against [plaintiff's] claims," and plaintiff's "patent counsel ... no longer [had] any recollection regarding their representation of [plaintiff] with respect to that patent"). Laches, however, has the power to preserve the fairness of trials by barring stale claims at the outset.

Without laches, the six-year recovery period of section 286 standing alone often would be insufficient to protect such interests of fairness. Particularly in a case where the defendant builds and expands its business during the period of the plaintiff's delay, the six-year recovery period would still allow the plaintiff to capture an enormous damages award, despite the fact that the damages were able to increase in that period because of the plaintiff's prejudicial delay in bringing suit. It is easy to imagine a plaintiff who is aware of a defendant's infringements, but who does not sue while the defendant pours capital into its product, the plaintiff preferring to wait and see if the defendant's efforts are profitable. Five, ten, even fifteen years later, if and when the defendant's efforts bear fruit, the plaintiff could file for infringement and

reap the benefits of the most recent—and often the most profitable—six years' worth of damages. The plaintiff could thus choose the timing and the amount of damages that were most crippling to the defendant's business, while exposing the defendant to the very real possibility that its witnesses have forgotten, moved on, or died, and its documents have been misplaced or destroyed. The Federal Circuit was entirely correct in *Aukerman* when it wrote that section 286 should not be interpreted to "provide, in effect, a guarantee of six years damages regardless of equitable considerations arising from delay in assertion of one's rights." 960 F.2d at 1030. Laches still has its equitable role to play in balancing the fairness of patent litigation and protecting defendants from such inequitable results.

II. Laches should be available in appropriate circumstances to bar an entire infringement suit, whether for damages, injunctive relief, or both.

For the reasons set forth in Part I above, laches should be available in appropriate circumstances to bar a claim for damages. Laches should also be available in appropriate circumstances to bar claims for equitable relief, including prospective injunctive relief. Depending on the case, district courts should maintain the flexibility to invoke laches to bar only certain remedies, or to dismiss the entire suit.

A. Laches should be available to bar a suit for equitable relief, including prospective injunctive relief.

This Court's precedent, both old and new, provides that laches may, where appropriate, bar any form of relief, legal or equitable. The *en banc* Federal Circuit here overruled *Aukerman's* holding that laches is "not

for post-filing ... injunctive relief." 960 F.2d at 1040. *SCA Hygiene*, 807 F.3d at 1331-33. That holding, too, should be maintained.

In *Lane & Bodley Co.*, this Court relied on laches to bar all claims for equitable relief. In that case, Locke invented a valve in 1872 and brought suit for patent infringement in 1884, seeking an injunction and an accounting. The Court found him guilty of laches and ordered that "the decree of the court below ... be [r]eversed, and the record remanded to the Circuit Court, with directions to dismiss the bill of complaint." 150 U.S. at 201. In other words, the Court invoked laches as a ground upon which to bar the entire suit, both the claim for an accounting as well as the claim for an injunction.

Petrella is not to the contrary. There, despite the existence of a three-year statute of limitations, the Court held that "in extraordinary circumstances, laches may bar at the very threshold the particular [equitable] relief requested by the plaintiff." 134 S. Ct. at 1967. The Court also discussed at length a case where there was copyright infringement in building a housing development, ultimately endorsing the lower court's refusal to order destruction of the homes on the basis of laches. *Id.* at 1978. Thus, even when there is a clear statute of limitations, this Court recognizes that laches may preclude equitable relief in appropriate circumstances. As explained above, there is no such statute of limitations in the patent context, leaving even more leeway for courts to invoke laches in denying equitable (and other) remedies.

Such a holding fully aligns with this Court's ruling in *eBay Inc. v. MercExchange, L.L.C.*, which emphasized the broad, discretionary applicability of

injunction law (itself a creature of equity): "[T]he decision whether to grant or deny injunctive relief [in patent cases] rests within the equitable discretion of the district courts, and ... such discretion must be exercised consistent with traditional principles of equity." 547 U.S. at 394.

Moreover, the arguments above in favor of allowing laches to bar claims for damages apply with equal force to equitable relief. Allowing laches to bar equitable remedies in appropriate cases serves important interests of fairness. If, based on a reasonable assumption that a plaintiff will not file suit, a defendant invests time and money in developing a product and building a business, it is not enough that laches shield him from damages down the road—laches should also be available to shield him from an injunction ordering him to cease production, which might put him out of business. Furthermore, evidentiary prejudice is just as much of a problem in a suit for an injunction as it is in a suit for damages—documents and witnesses are lost, and memories fade. Even when only equitable relief is requested, the equitable defense of laches is necessary to protect defendants from stale claims.

In sum, in light of this Court's precedent—and the realities of litigating stale claims in the patent context—laches should be available to bar suits for equitable relief.

B. District courts should retain the power to bar claims for legal relief, for equitable relief, or for both, and to dismiss an entire suit, based on laches.

In the final analysis, laches is an equitable doctrine, and district courts retain discretion regarding its

application. As this Court has long held, there are "inherent equitable powers" in district courts "to do equity and to mould each decree to the necessities of the particular case." *Porter v. Warner Holding Co.*, 328 U.S. 395, 398 (1946) (quoting *Hecht Co. v. Bowles*, 321 U.S. 321, 329 (1944)). Courts "may act so as to adjust and reconcile competing claims and so as to accord full justice to all the real parties in interest." *Id.* Laches is one of these powers, residing firmly within the discretion of the trial court. *See Gardner v. Panama R.R. Co.*, 342 U.S. 29, 30 (1951) (*per curiam*). As *Aukerman* realized: "With its origins in equity, a determination of laches is not made upon the application of 'mechanical rules.' The defense, being personal to the particular party and equitable in nature, must have flexibility in its application. A court must look at all of the particular facts and circumstances of each case and weigh the equities of the parties." 960 F.2d at 1032 (internal quotation marks and citations omitted); *see also Holmberg v. Armbrecht*, 327 U.S. 392, 396 (1946) ("Equity eschews mechanical rules; it depends on flexibility").[7]

For the reasons set forth above, laches should be available as a defense to claims for damages and claims for injunctive relief. As an equitable doctrine, there should be no rigid or categorical rules to its application. Rather, laches should be available to bar

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[7] Not only does equity frown upon "mechanical rules," this Court has, over the past several years, rejected efforts to impose mechanical or bright-line rules for patent cases in a number of instances. *See, e.g., Halo Elecs.*, 136 S. Ct. at 1932-34; *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *eBay Inc.*, 547 U.S. 388; *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). The court of appeals' decision here is in full accord with this Court's approach in those cases.

damages or injunctions or both, to deny certain remedies or to dismiss an entire suit, depending on the facts of the case. *Compare McLean v. Fleming*, 96 U.S. 245, 258 (1877) (laches barred an accounting and profits, but not an injunction), *with Lane & Bodley Co.*, 150 U.S. at 201 (laches required that the entire bill be dismissed). And laches should be available to bar claims and cases at the outset, as cases from *Lane & Bodley Co.* to *Petrella* have recognized; consideration of laches should not wait until the remedial phase. *Lane & Bodley Co.*, 150 U.S. at 201 (instructions to dismiss the bill); *Petrella*, 134 S. Ct. at 1977 (role for laches "at the very outset of the litigation"); *see also, e.g., Nat'l R.R. Passenger Corp.*, 536 U.S. at 121 (laches can "bar[] a plaintiff from maintaining a suit").

In sum, the Court should retain the defense of laches in patent cases, and preserve the discretion of district judges to bar some or all aspects of a patent lawsuit, whether for damages or injunction, or both.

CONCLUSION

The court of appeals' judgment should be affirmed.

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Respectfully submitted,

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APPENDIX

APPENDIX[1]

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